



# UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE  
United States Patent and Trademark Office  
Address: COMMISSIONER FOR PATENTS  
P.O. Box 1450  
Alexandria, Virginia 22313-1450  
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/488,079	01/20/2000	David R. Montague	2779.2.2	3921

28049 7590 02/07/2005

PATE PIERCE & BAIRD  
215 SOUTH STATE STREET, SUITE 550  
PARKSIDE TOWER  
SALT LAKE CITY, UT 84111

EXAMINER

MYHRE, JAMES W

ART UNIT	PAPER NUMBER
----------	--------------

3622

DATE MAILED: 02/07/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

# Office Action Summary

Application No.

09/488,079

Applicant(s)

MONTAGUE, DAVID R.

Examiner

James W Myhre

Art Unit

3622

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

## Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

## Status

- 1) ☒ Responsive to communication(s) filed on 09 September 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

## Disposition of Claims

- 4) ☒ Claim(s) 1-28 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-28 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

## Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

## Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

## Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 4) ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date \_\_\_\_\_.
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: \_\_\_\_\_.

### DETAILED ACTION

1. In view of the Board of Patent Appeals and Interferences (BPAI) Decision on September 9, 2004, PROSECUTION IS HEREBY REOPENED. A new grounds of rejection is set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

- (1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,
- (2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

### ***Claim Rejections - 35 USC § 103***

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-28 are rejected under 35 U.S.C. 103(a) as being unpatentable over Dlugos Sr. et al (5,153,842) in view of Redford et al (US2001/0003041).

Claims 1, 11, 18, and 24: Dlugos discloses a method and apparatus for attaching product labels comprising:

- a. Affixing a label to a product surface (col 5, lines 48-56);
- b. Configuring the label to provide information corresponding to at least the product and/or source of product (col 3, lines 19-23 and 53-57); and
- c. Coupling a computer readable medium containing computer executable instructions (i.e. program) to the label (col 3, lines 39-42 and col 5, lines 48-59).

While Dlugos does not explicitly disclose that the computer executable instructions on the computer readable medium are executable by a computer of the purchaser of the product, Redford discloses a similar method and apparatus of attaching a computer readable medium (optical disk) to an item and further discloses that "on insertion of an optical disk or other such storage media, host device 120 can automatically suspend the display of any current displayed information and automatically start execution of software retrieved from the storage media" (page 7, paragraph 0105). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to store computer executable instructions (software) on the computer readable medium attached to the item in Dlugos. One would have been motivated to include software on the disk to display additional information about the item (e.g. operating instructions, troubleshooting, etc.) or to automatically update the item information stored thereon as discussed by Redford or to provide for automatic registration of the item as discussed by Dlugos.

Claims 2, 12, and 19: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1, 11, and 18 above, and Dlugos further discloses the information is printed on the label (col 3, lines 19-23).

Claims 3, 13, and 20: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 2, 12, and 19 above, but do not explicitly disclose that the printed information is contained in a selection of color on the label. Official Notice is taken that it is old and well known within the marketing arts to use color to differentiate between various labels and tags; such as a clothing store using pink hang tags to indicate that the garment's size is Small, light blue hang tags to indicate that the garment's size is Medium, and green hang tags to indicate that the garment's size is Large. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to use labels of various colors in Dlugos. One would have been motivated to use labels of different color in order to facilitate quick and easy identification of the product or product manufacturer by the merchant, the shipper, and the customer (e.g. a blue label for a product made by IBM, whose nickname is "Big Blue").

Claims 4, 14, and 21: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1, 11, and 18 above. While Dlugos prefers that the label is the same size and shape as a credit card, it is also disclosed that the label "may be of an overall shape or size different from the standard credit card" (col 6, lines 11-23). However, Dlugos does not explicitly disclose using a trademark symbol on the label to identify the product or the source of the product. Official Notice is taken that it is old and

Art Unit: 3622

well known within the marketing arts to use trademark symbols to identify both products and product sources; indeed, that is the purpose for registering trademarks. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to include a trademark symbol on the label in Dlugos. One would have been motivated to include a trademark symbol on the label in order to facilitate quick and easy identification of the product and its source.

Claims 5, 15, and 22: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1, 11, and 18 above, and Dlugos further discloses the computer readable medium containing information pertaining to product facts, source facts, data gathering interface, and many other types of information for use by the receiver, sender, and/or shipper (col 9, lines 49-62).

Claim 6: Dlugos and Redford disclose an apparatus for attaching product labels as in Claim 1 above, and Dlugos further discloses that the label may be attached in various ways to a wide variety of products (col 5, line 48 - col 6, line 23).

Claim 7: Dlugos and Redford disclose an apparatus for attaching product labels as in Claim 6 above, and Dlugos further discloses placing the label onto the product in a manner which protects the label from damage (col 5, lines 48-56).

Claims 8 and 16: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1 and 11 above, and Dlugos further discloses the label is a hang tag enclosing the computer readable medium (col 5, lines 48-56).

Claims 9 and 17: Dlugos and Redford disclose an apparatus for attaching product labels as in Claims 1 and 11 above, and Dlugos further discloses that the

computer readable medium includes a printed medium or an electromagnetic medium (col 3, lines 19-23 and 39-52).

Claim 10: Dlugos and Redford disclose an apparatus for attaching product labels as in Claim 9 above, and Dlugos further discloses that the computer readable medium is formatted as a bar code or embedded chip (col 3, lines 12-13, col 4, lines 52-57, and col 4, line 67 - col 5, line 8).

Claim 23: Dlugos and Redford disclose an apparatus for attaching product labels as in Claim 18 above. While various methods of attaching the label to the product are disclosed, including inserting the label into a small pouch, using clips or brackets, etc., it is not explicitly disclosed that the opening into which the label is inserted penetrates all the way into the interior of the product. However, it would have been obvious that such a method of attachment could be used, depending upon the actual product, of course. One would have been motivated to use this or other methods to attach the label to the product in order to prevent or reduce the likelihood that the label would become detached during shipping or handling as discussed by Dlugos.

Claim 25: Dlugos and Redford disclose a method for attaching product labels as in Claim 24 above, and Dlugos further discloses that the product is packaged with a "clear plastic film or packing material containing air bubbles" (col 5, lines 49-51).

Claim 26: Dlugos and Redford disclose a method for attaching product labels as in Claim 24 above, and Dlugos further discloses that the label is attached to the outside of the product using a flexible member (i.e. the label is a tag)(col 5, line 60 - col 6, line 2).

Claims 27 and 28: Dlugos discloses an apparatus for attaching product labels, comprising:

- a. A label affixed to a product surface at the source of the product (col 5, lines 48-56);
- b. Configuring the label to provide advertising information corresponding to at least the product and/or source of product (col 3, lines 19-23 and 53-57); and
- c. Coupling a computer readable medium containing computer executable instructions (i.e. program) to the product by the label (col 3, lines 39-42 and col 5, lines 48-59).

While Dlugos does not explicitly disclose that the computer executable instructions on the computer readable medium are executable by a computer of the purchaser of the product, Redford discloses a similar method and apparatus of attaching a computer readable medium (optical disk) to an item and further discloses that "on insertion of an optical disk or other such storage media, host device 120 can automatically suspend the display of any current displayed information and automatically start execution of software retrieved from the storage media" (page 7, paragraph 0105). Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to store computer executable instructions (software) on the computer readable medium attached to the item in Dlugos. One would have been motivated to include software on the disk to display additional information about the item (e.g. operating instructions, troubleshooting, etc.) or to

Art Unit: 3622

automatically update the item information stored thereon as discussed by Redford or to provide for automatic registration of the item as discussed by Diugos.

It is inherent that since the label in Diugos is on the outside of the product, it is viewable by the prospective purchaser or anyone else who looks at the product.

### ***Conclusion***

4. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

a. Lanpher et al (5,333,106) discloses a method and apparatus for attaching a data storage device to a product which contains computer readable instructions to enable the user to learn and monitor the correct usage of an aerosol pharmaceutical product.

b. Grundy (5,375,240) discloses a method and apparatus for distributing information on a machine readable medium which includes executable instructions for registering the software on the machine readable medium.

c. Redford et al(5,711,672) discloses a method and apparatus for automatically starting the execution of computer readable instructions stored on a storage media which automatically copies a new version of the software into the storage media.

d. Tycksen, Jr. et al (5,898,777) discloses a method and apparatus for disseminating digital products storing a plurality of software programs as packages.

e. Ronning (5,907,617) discloses a method and apparatus for distributing software on a storage media which also contains executable instructions for tracking and reporting the number of times the software was used.

f. Takahashi et al (6,195,432) discloses a method and apparatus for distributing software on a storage media which contains executable instructions for downloading updated and full versions of the software.

g. Fuller et al (6,216,112) discloses a method and apparatus for distributing software on a storage media which also including executable instructions for retrieving and presenting advertisements to the user.

h. Collart (6,405,203) discloses a method and apparatus for preventing unauthorized use of the contents on a storage media by executing stored instructions to retrieve authorization (and codes) from a remote device.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Exr. James W. Myhre whose telephone number is (703) 308-7843. The examiner can normally be reached Monday through Thursday from 6:30 a.m. to 3:30 p.m.

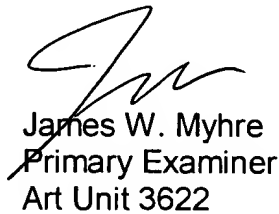
If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Eric Stamber, can be reached on (703) 305-8469. The fax phone number for Formal or Official faxes to Technology Center 3600 is (703) 872-9306. Draft or Informal faxes, which will not be entered in the application, may be submitted directly to the examiner at (703) 746-5544.

Note: Effective April 2005, the examiner's telephone numbers will be changed to (571) 272-6722 (phone) and (571) 273-6772 (Informal faxes); and the examiner's supervisor's telephone number will be changed to (571) 272-6724.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group Receptionist whose telephone number is (703) 308-1113.



JWM  
February 2, 2005



James W. Myhre  
Primary Examiner  
Art Unit 3622



JOHN J. LOVE  
DIRECTOR  
TECHNOLOGY CENTER 3600